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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,450	10/19/2001	Keith E.G. Emery	10007533-1	4069

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SHAH, MANISH S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,450

Applicant(s)

EMERY, KEITH E.G.

Examiner

Manish S. Shah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-31 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 32-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-12 & 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant amended the claims to optical storage medium and optical storage medium includes lands and pits. However the specification didn't teach about the optical storage medium, in the specification at page 8, line: 29-32, it teaches that the equipment optionally includes a cradle that holds and allows for positioning of the laser and/or optical elements, which is not same as optical storage medium. The element 220 in the figures is a regular storage medium, not an optical storage medium. The specification didn't teach that the optical storage medium has lands and pits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8 & 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Saruta et al. (# US 6533383).

Saruta et al. discloses a print cartridge including read and/or write storage medium (see Abstract; column: 16, line: 43-52) operable using an electromagnetic beam (column: 16, line: 45-52), wherein cartridge including inkjet printer cartridge (see Abstract; figure: 2, 3a-3b; 7, 8a-8b).

3. Claims 32-33, 35-36 & 38-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Saruta et al. (# US 6533383).

Saruta et al. discloses a replaceable print cartridge including read and/or write storage medium (see Abstract; column: 16, line: 43-52, figure: 2, 7) operable using an electromagnetic beam (column: 16, line: 45-52), wherein cartridge including inkjet printer cartridge (see Abstract; figure: 2, 3a-3b; 7, 8a-8b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saruta et al. (# US 6533383) in view of Gamblin et al. (# US 3656827).

Saruta et al. discloses a replaceable print cartridge including read and/or write storage medium (see Abstract; column: 16, line: 43-52, figure: 2, 7) operable using an electromagnetic beam (column: 16, line: 45-52), wherein cartridge including inkjet printer cartridge (see Abstract; figure: 2, 3a-3b; 7, 8a-8b).

Saruta et al. differs from the claim of the present invention in that the storage medium comprises a hologram using an electromagnetic beam.

Gamblin teaches the storage medium is a hologram (Abstract), the hologram comprises a writeable, readable (see Abstract, Column: 3, line: 22-50) and hologram can be written using a laser which is electromagnetic beam.

It would have been obvious to one having ordinary skill in the art at the time the invention was made as modify to have the storage medium comprises a hologram using electromagnetic beam as taught by Gamblin. The motivation of doing so is obtain a greater volumetric efficiency in storage and lower cost.

5. Claims 9 & 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saruta et al. (# US 6533383) in view of Gamblin et al. (# US 3656827).

Saruta et al. teaches all the limitation of the print cartridge except that the storage medium comprises a hologram using an electromagnetic beam.

Gamblin teaches the storage medium is a hologram (Abstract), the hologram comprises a writeable, readable (see Abstract, Column: 3, line: 22-50) and hologram can be written using a laser which is electromagnetic beam.

It would have been obvious to one having ordinary skill in the art at the time the invention was made as modify to have the storage medium comprises a hologram using electromagnetic beam as taught by Gamblin. The motivation of doing so is obtain a greater volumetric efficiency in storage and lower cost.

6. Claims 10 & 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saruta et al. (# US 6533383) in view of Bullock et al. (# US 5,812,156).

Saruta et al. teaches all the limitation of the print cartridge except that the storage medium comprises indicia of authenticity.

Bullock teaches the storage medium comprises indicia of authenticity (column: 4, line: 23-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made as modify to have the storage medium comprises indicia of authenticity and manufacturing line as taught by Bullock. The motivation of doing so is provide updated parameters to customers who already have installed printers.

Allowable Subject Matter

7. Claims 13-31 are allowed.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

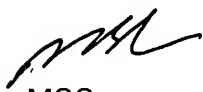
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manish S. Shah
Primary Examiner
Art Unit 2853


MSS
3/4/05